

REMARKS

Claims 36 and 46 to 51 are canceled without prejudice, and therefore claims 16 to 20, 22, 24 to 35, and 37 to 42 are now pending.

It is respectfully requested that the Examiner acknowledge acceptance of the drawings in the next Office communication.

It is first noted that a non-substantive response (statement of the substance of the interview) to the 2/24/05 Office Action preceded this paper and was filed on 3/15/05. As to the Interview, on February 22, 2005, Examiner Anita Karen Alonko initiated a phone call with Aaron C. Deditch (reg. no. 33,865) to offer proposed amendments to the claims by limiting the claims to annealing, in view of the references herein. Examiner Alonko advised that she would allow the case if the claims were so limited. While agreement could not be reached at that time because of time constraints, and while the rejections may not be agreed with, to facilitate matters, the claims have now been rewritten as suggested. Accordingly, it is respectfully submitted that claims 16 to 20, 22, 24 to 35 and 37 to 42 are allowable. It is noted that claims 16, 35, 39 and 46 have been corrected as suggested in the claim objections of page 2 of the Final Office Action.

With respect to page two (2) of the Final Office Action, claims 16-20, 22, 24-42 and 46-51 were objected to, and have been rewritten as suggested. It is therefore respectfully requested that the objections be withdrawn.

As to the objections to the specification, the specification has been corrected as suggested by the Examiner. No new matter has been added. It is therefore respectfully requested that the objections to the specification be withdrawn.

While the anticipation and obviousness rejections may not be agreed with, to facilitate matters, the claims have now been rewritten as suggested in the prior interview. Accordingly, it is respectfully submitted that claims 16 to 20, 22, 24 to 35 and 37 to 42 are allowable, as explained below.

With respect to page three (3), claims 16 to 18, 20, 22, 24 to 26, 35 to 42 and 46 to 51 were rejected under 35 U.S.C. § 102(e) as anticipated by Tu, U.S. Patent No. 6,359,276.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, the claims have now been rewritten as suggested in the prior interview. Accordingly, it is respectfully submitted that claims 16 to 20, 22, 24 to 35 and 37 to 42 are allowable. Claims 36 and 46 to 51 were canceled without prejudice. It is therefore respectfully requested that the anticipation rejections be withdrawn.

Claims 16 to 20, 22, 24 to 28, 35 to 42 and 46 to 51 were rejected under 35 U.S.C. § 103(a) as obvious over the “Seefeldt” reference. Claims 16 to 20, 22, 24 to 26, 35 to 42 and 46 to 51 were rejected under 35 U.S.C. § 103(a) as obvious over the “Seefeldt” reference in view of “Brendel”, U.S. Published Patent Application No. 2003/0017712 A1. Claims 16 to 20, 22, 24 to 28, 35 to 42 and 46 to 51 were rejected under 35 U.S.C. § 103(a) as obvious over the Tu reference in view of the “Seefeldt” reference. Claims 16 to 20, 22, 24 to 26, 35 to 42 and 46 to 51 were rejected under 35 U.S.C. § 103(a) as obvious over the “Tu” reference in view of the “Brendel” reference.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

While the rejections may not be agreed with, to facilitate matters, the claims have now been rewritten as suggested in the prior interview. Accordingly, it is respectfully submitted that claims 16 to 20, 22, 24 to 35 and 37 to 42 are allowable. Claims 36 and 46 to 51 were canceled without prejudice. Claim 35 now depends from claim 17 as suggested. It is therefore respectfully requested that the obviousness rejections be withdrawn.

It is therefore respectfully submitted that all of claims 16 to 20, 22, 24 to 35, and 37 to 42 are allowable.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 16 to 20, 22, 24 to 35 and 37 to 42 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,
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